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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,121	06/22/2001	Peter J. Dronzek JR.	559-018	8226

7590

08/27/2003

HEDMAN & COSTIGAN, P.C.  
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New York, NY 10036

EXAMINER

CARTER, MONICA SMITH

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 08/27/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/888,121

Applicant(s)

DRONZEK ET AL.

Examiner

Monica S. Carter

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 8/11/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. The request filed on August 11, 2003 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/888,121 is acceptable and an RCE has been established. An action on the RCE follows.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda et al. ('754).

Yasuda et al. disclose an in-mold label/ article of manufacture with a coupon comprising at least one removable section (5- coupon which, inherently, receives printing) and at least one permanent section (sections located on the opposite surfaces of the adhesive 3 in figure 1), the removable section consisting essentially of a part of the label which is defined by two or more notches (6) spaced apart on the same edge of the label (as seen in figure 1); the notches being located so that a line which is extended to connect the notches is substantially perpendicular to the axis of orientation of the label (as seen in figure 1, a line connecting the notches 6 provides a line that is perpendicular to the axis of orientation, wherein the axis of orientation is indicated by

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the arrow located above the upper dashed line of 4b) and the notches being located at the interface of the permanent and removable sections (as seen in figure 1, notches 6 are located between the removable section and the permanent sections).

Yasuda et al. disclose the claimed invention except for the particular material of the label as claimed (claims 1-17). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any type of material (i.e. polymeric film that is uniaxially oriented in line with the direction of tear by stretching in one direction only, opaque or clear virgin olefin homopolymer, etc.) as necessitated by the end user, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416. Furthermore, the uniaxially oriented, polymeric film being in line with the direction in which the tear-removable section is to be removed by stretching in one direction only does not structurally limit the claim. The patentability of a product does not depend on its method of production. Product-by-Process claims are not limited to the manipulations of recited steps, only the structure implied by the steps. (See MPEP 2113)

Regarding claims 2 and 8, it would have been an obvious matter of design choice to provide the label with any desired dimensions, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 7, see the above rejections. Further, Yasuda et al. disclose the adhesive layer (3) being continuously applied to both the permanent and removable sections of the label (see figure 2 and col. 2, lines 57-65).

### ***Response to Arguments***

4. Applicant's arguments filed August 11, 2003 have been fully considered but they are not persuasive.

Applicant argues that Yasuda et al. disclose a biaxially-oriented film prepared by first stretching in the machine direction then stretching in the transverse direction. Applicant argues that this is in contrast to the present invention. The examiner maintains that the material selected by the user for the label would determine the particular properties associated with the label. Furthermore, how the material is prepared (stretching in one direction only) does not structurally limit the invention. The patentability of a product does not depend on its method of production.

Applicant argues that Yasuda et al. fail to disclose that the adhesive layer is always put down before a continuous layer of adhesive is put down overall. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As seen in figure 2, adhesive is applied to both the permanent sections and the removable section of the label. Yasuda et al.

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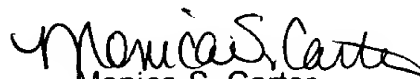
disclose that zone 4 is a less adhesive zone and that part 4a is free of adhesive for forming a non-adhesive stripping starting part. Applicant has failed to claim that the adhesive is continuous across the surfaces in their entirety.

**Conclusion**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

  
Monica S. Carter  
Primary Examiner  
Art Unit 3722

August 25, 2003